

REMARKS

By this Office Action, the Examiner has required restriction to one of the following inventions under 35 U.S.C. §121:

- Group 1. Claims 1-5, and 7, drawn to a method of screening for breast, lung and pancreatic cancer comprising detecting an NKCCI polypeptide.
- Group 2. Claims 1-5, and 7, drawn to a method of screening for breast, lung and pancreatic cancer comprising detecting a nucleic acid molecule.
- Group 3. Claims 1-5, and 7, drawn to a method of screening for breast, lung and pancreatic cancer comprising detecting an NKCCI polypeptide and a nucleic acid molecule.
- Group 4. Claims 6, 8, and 9, drawn to an antibody that specifically binds to a polypeptide.
- Group 5. Claims 10, 16, and 17, drawn to a method for the prophylaxis and/or treatment of cancer comprising administering a polypeptide.
- Group 6. Claims 10, 16, and 17, drawn to a method for the prophylaxis and/or treatment of cancer comprising administering a nucleic acid.
- Group 7. Claims 10, 16, and 17, drawn to a method for the prophylaxis and/or treatment of cancer comprising administering a polypeptide and a nucleic acid.
- Group 8. Claim 11, drawn to a method for the prophylaxis and/or treatment of cancer comprising administering an antibody.
- Group 9. Claims 18 and 19, drawn to a method of screening for agents that interact with a polypeptide.
- Group 10. Claims 20-22, drawn to a method of screening for cancer agents that modulate the expression or activity of a polypeptide for further testing an anti-cancer agent.
- Group 11. Claims 20-22, drawn to a method of screening for cancer agents that modulate the expression of a nucleic acid.
- Group 12. Claims 23 and 25, drawn to an agent that binds a polypeptide and causes the expression or activity of that polypeptide to change.

Group 13. Claims 23 and 25, drawn to an agent that binds a polypeptide and causes the expression of a nucleic acid to change.

Group 14. Claim 26, drawn to a method for the prophylaxis and/or treatment of cancer comprising administering an active agent that interacts with a polypeptide which modulates the expression of the polypeptide.

Group 15. Claim 26, drawn to a method for the prophylaxis and/or treatment of cancer comprising administering an active agent that interacts with a polypeptide which modulates the expression of nucleic acid molecule.

Group 16. Claim 27, drawn to an agent identified by a method of screening for cancer agents that modulate the expression of a polypeptide.

Group 17. Claim 27, drawn to an agent identified by a method of screening for cancer agents that modulate the expression of a nucleic acid.

Responsive to the Requirement for restriction, Applicants elect to prosecute the invention of Group 8, with traverse, Claim 11, drawn to a method for the prophylaxis and/or treatment of cancer comprising administering an antibody.

Applicants respectfully request reconsideration of the Requirement for Restriction, or in the alternative, modification of the Restriction Requirement to allow prosecution of more than one group of Claims designated by the Examiner in the present Application, for the reasons provided as follows.

Under 35 U.S.C. §121 "two or more independent and distinct inventions ... in one Application may ... be restricted to one of the inventions." Inventions are "'independent'" if "there is no disclosed relationship between the two or more subjects disclosed" (MPEP 802.01). The term "'distinct'" means that "two or more subjects as disclosed are related ... but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE OVER EACH OTHER" (MPEP 802.01) (emphasis in original). However, even with patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

Further, under Patent Office Examining Procedures, "[i]f the Search and Examination of an entire Application can be made without serious burden, the Examiner must examine it on the

merits, even though it includes claims to distinct or independent inventions" (MPEP 803, Rev. 8, May 1988) (emphasis added).

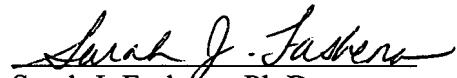
Applicants respectfully submit that the groups designated by the Examiner fail to define methods with properties so distinct as to warrant separate Examination and Search. Claims 10, 16, and 17 of Group 5, drawn to a method for the prophylaxis and/or treatment of cancer comprising administering a polypeptide, are fundamentally related to Claim 11 of Group 8, drawn to a method for the prophylaxis and/or treatment of cancer comprising administering an antibody. The search for any of the methods separately classified by the Examiner as the invention of Group 8 would require an additional search of the identical classes wherein the claims of Group 5 are classified, thus resulting in a duplicate search for the same material. In brief, the method of using "an antibody", as called for in the invention of Group 8, falls within the broader category of the method of using "a polypeptide", as called for in the invention designated as Group 5. Thus, Applicants submit that the Search and Examination of the entire Application, or, at least, of Group 5 with Group 8 can be made without serious burden, and therefore the Examiner should examine all of the claims of the Application on the merits.

The Examiner's assertions to the contrary notwithstanding, Applicants respectfully submit that conjoint examination and inclusion of all of the Claims of the present Application would not present an undue burden on the Examiner, and accordingly, withdrawal of the Requirement for Restriction, or, at the least, modification to include the Claims drawn to Group 8 and Group 5 is in order.

No fees are believed to be necessitated by the foregoing Response. However, should this be erroneous, authorization is hereby given to charge Deposit Account No. 11-1153 for any underpayment, or credit any overages.

In view of the above, an early action on the merits of the Claims is courteously solicited.

Respectfully submitted,


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